UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,890	02/04/2004	Jeffrey Gabbay	082799-000100US	5373

20350 7590 06/06/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
STITZEL, DAVID PAUL	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/772,890	GABBAY, JEFFREY	
	Examiner	Art Unit	
	David P. Stitzel, Esq.	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-9,27 and 28* is/are pending in the application.

4a) Of the above claim(s) *1-3,10-26 and 29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-9,27 and 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/2/04; & 12/10/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

OFFICIAL ACTION

Restriction/Election

Receipt of the Applicant's Election, *without traverse*, of Invention I, encompassing claims 4-9, 27 and 28, which was filed on April 18, 2006, in response to the Official Action mailed on January 18, 2006, is acknowledged.

Status of Claims

Claim 29 was added by an amendment that accompanied the aforementioned Election. However, claim 29 is directed to various devices, as set forth in Inventions III-VIII. Therefore, claims 1-3, 10-26 and 29 are withdrawn from further consideration as being directed to a non-elected invention. As a result, claims 4-9, 27 and 28 are currently pending and therefore examined herein on the merits for patentability.

Nonstatutory Double Patenting

A nonstatutory double patenting rejection of the "obviousness-type" is based on a judicially created doctrine grounded in public policy so as to prevent not only the unjustified or improper timewise extension of the "right to exclude" granted by a patent, but also possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); and *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned or assigned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. See MPEP § 804. However, this does not mean that one is absolutely precluded from all use of the patent disclosure. See MPEP § 804. For example, the specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Furthermore, ***those portions of the specification which provide support for the patent claims may also be examined and considered*** when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-442, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* stated that one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court in *Vogel* also pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. § 103, since only the disclosure of the invention claimed in the patent may be examined."

1. Claims 4-7, 27 and 28 of the instant application are provisionally rejected under the judicially created doctrine of non-statutory obviousness-type double patenting as being unpatentable over conflicting claims 1-4 of copending U.S. Pre-Grant Patent Application Publication 2004/0247653 (hereinafter the conflicting Gabbay '653 publication).

More specifically, claims 4-7, 27 and 28 of the instant application are directed to an antiviral hydrophilic polymeric material in the form of a film comprising: a hydrophilic polymer selected from the group consisting of polyvinylalcohol, acrylic, nitrile, "silastic rubber" or latex; and a cationic copper powder mixture of water insoluble particles of divalent copper cations Cu^{++} and univalent copper cations Cu^{+}; wherein said water insoluble particles are from about 1 μm to about 10 μm in diameter and are encapsulated within said hydrophilic polymer in an amount from about 1 wt. % to about 3 wt. %.

Claims 1-4 of the conflicting Gabbay '653 publication are directed to an antimicrobial and antiviral polymeric material in the form of a sheet comprising: a polymer selected from the group consisting of polyamide, polyalkylene, polyester and acrylic; and a cationic copper powder mixture of water insoluble particles of divalent copper cations Cu^{++} (released from a cupric oxide or CuO) and univalent copper cations Cu^{+} (released from cuprous oxide or Cu_2O); wherein said water insoluble particles are from about 1 μm to about 10 μm in diameter and are embedded within said polymer in an amount from about 0.25 wt. % to about 10 wt. %.

As a result, although claims 4-7, 27 and 28 of the instant application are not identical to claims 1-4 of the conflicting Gabbay '653 publication, the aforementioned claims are not patentably distinct each from the other because said claims are substantially overlapping in scope

as discussed hereinabove. This is a provisional non-statutory double patenting rejection since the conflicting claims have not yet been patented.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102, which forms the basis of the anticipation rejections as set forth under this particular section of the Official Action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-9, 27 and 28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,180,585 (hereinafter the Jacobson '585 patent).

With respect to claims 4-9, 27 and 28 of the instant application, the Jacobson '585 patent discloses an antiviral polymeric material comprising a shaped article of a synthetic polymer that is coated with a coating of a cationic copper powder mixture of water insoluble particles of divalent copper cations Cu^{++} (released from a cupric oxide or CuO) and univalent copper cations Cu^{+} (released from cuprous oxide or Cu_2O); wherein said cationic copper powder mixture of water insoluble particles of divalent and univalent copper cations is pre-coated with a synthetic polymer prior to coating said shaped article; wherein said synthetic polymer of said shaped article and said synthetic polymer for pre-coating said cationic copper powder mixture of water insoluble particles of divalent and univalent copper cations is selected from the group consisting of polyamides (i.e., nylon), polyolefins (i.e., polyethylene and polypropylene), polyvinylalcohol, polyesters and acrylics; wherein said water insoluble particles are from about 0.01 μm to about

100 μm in diameter, preferably from about 0.1 μm to about 5 μm in diameter, and are uniformly dispersed and incorporated within the polymeric matrix of said synthetic polymer in an amount from about 0.1 wt. % to about 60 wt. %, preferably from about 0.1 wt. % to about 15 wt. %, and most preferably from about 0.3 wt. % to about 2 wt. % (column 1, lines 1-33; columns 2-4; column 5, lines 29-68; column 6, lines 1-21; column 8, lines 40-68; columns 9-12).

Conclusion

Claims 4-9, 27 and 28 are rejected because the claimed invention is anticipated since each and every element of the claimed invention, as a whole, is disclosed in the cited prior art references.

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq. whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see http://pair-direct.uspto.gov. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David P. Stitzel, M.S., Esq.
Patent Examiner
Technology Center 1600
Group Art Unit 1616
May 2, 2006

Johann Richter, Ph.D., Esq.
Supervisory Patent Examiner
Technology Center 1600
Group Art Unit 1616